UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,693	10/25/2000	William Fitzpatrick	4797-30	3242

30551 7590 04/26/2005	EXAMINER
LESLIE GLADSTONE RESTAINO	CHENCINSKI, SIEGFRIED E

LESLIE GLADSTONE RESTAINO
BROWN RAYSMAN MILLSTEIN & STEINER LLP
163 MADISON AVENUE
PO BOX 1989
MORRISTOWN, NJ 07962-1989

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _22 October 2004_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,2 and 4-16_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,2 and 4-16_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 22, 2004 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness s rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   **Claims 1 & 4-11 are rejected** under 35 U.S.C. 103(a) as being disclosed by Clark et al.(US Patent 5,710,889, hereafter Clark) in view of Maggioncalda et al. (US Patent 5,918,217, hereafter Maggioncalda), Wolfberg et al. (US Patent 5,214,579, hereafter Wolfberg) and Earle (US Patent 5,262,942).

Re. Claim 1, Clark discloses an integrated system for providing financial services, comprising:

- at least one workstation having a central processing unit and a video display screen (Fig's 1 & 15; Col. 2, l. 36 – Col. 3, l. 34; Col. 26, l. 56 – Col. 27, l. 13);

- at least one host server (Fig's 1 & 15; Col. 2, l. 36 – Col. 3, l. 34; Col. 26, l. 56 – Col. 27, l. 13);;

- the at least one host server connected to the at least one workstation over a communication system for transmitting information between a workstation and at least one host server (Fig's 1 & 15; Col. 2, l. 36 – Col. 3, l. 34; Col. 26, l. 56 – Col. 27, l. 13);

- an application interface operable on the workstation for accessing at least on a plurality of finance-related software applications comprising a real-time market data application (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and

- a real-time investor monitoring system for monitoring investor mediated transactions (Real time - Col. 10, line 49; Col. 11, ll. 16-23), the system to provide timely proactive financial advice to investors (Clark's system is presented for the purpose providing financial services to customers, including financial advice).

Clark do not explicitly disclose the providing of all inclusive financial advice, such as financial planning advice. However, Maggioncalda disclose the providing of a financial planning application (Col. 2, line 33 – Col. 3, line 63; Col. 5, lines 32-33). Also, Clark do not explicitly disclose the provision of timely proactive transaction advice to the client. However, Wolfberg discloses providing timely proactive transaction advice to the client (Col. 24, ll. 43-52). Finally, Clark do not explicitly disclose enabling a user therewith to provide timely proactive transaction advice to the client user. However, Earle discloses the enabling of a user therewith to provide timely proactive transaction advice to the client user (Col. 7, ll. 48-59; Col. 9, ll. 54-57). It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda, Wolfberg and Earle for the purpose of a financial advisory system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, protects them from mistakes and, perhaps most importantly, provides an opportunity for their financial decisions to meet their investment goals for the future. The motivation for the practitioner at the time of Applicant's invention to invent such a system would have been to provide an investment management system which enables an investment client to achieve superior investment performance (Maggioncalda, Col. 1, ll. 54-55).

Re. Claim 4, Clark discloses an integrated system wherein the real-time market data application provides real-time market data comprising at least one of: quotes, news, and historical and intraday charting (Col. 3, ll. 23-25; Col. 7, l. 28-31; Col. 10, line 49; Col. 11, line 18, a server is inherent).

Re. Claim 5, Clark discloses an integrated system wherein the
real-time market data application provides a valuation ratings for at least one financial
instrument (Col. 24, II. 43-49).

Re. Claim 6, Clark discloses an integrated system wherein the application interface
further includes a scratchpad application for moving information between applications
(Inherent in MS Windows).

Re. Claim 7, Clark does not explicitly disclose an integrated system wherein the
communication system connects a workstation to at least one host server via the
Internet. However, Maggioncalda discloses an integrated system as recited by claim 1,
wherein the communication system connects a workstation to at least one host server
via the Internet (Col. 6, line 65).
It would have been obvious at the time of Applicant's invention to have combined the
disclosures of Clark with those of Maggioncalda for the purpose of providing an
integrated financial services system which can perform a number of different finance-
related functions wherein the system connects a workstation to a host server via the
internet.

Re. Claim 8, Clark does not explicitly disclose an integrated system as recited by claim
1, further comprising a financial advisor. However, Maggioncalda discloses an
integrated system as recited by claim 1, further comprising a financial advisor (Page 2,
Other Publications, Title – Net Results™, "Your On-Line Financial Advisor").
It would have been obvious at the time of Applicant's invention to have combined the
disclosures of Clark with those of Maggioncalda for the purpose of providing financial
services which include an on-line financial advisor.

Re. Claim 9, Clark discloses an integrated system further comprising an authentication
system for determining user entitlements and accessing a user preference profile
(Abstract; Col. 2, lines 48-50; Col. 5, line 63 – Col. 6, line 16; Col. 6, lines 36-47).

Re. Claim 10, Clark discloses an integrated system wherein the authentication system
populates the application interface based on the user entitlements (Col. 5, lines 13-28;
Col. 25, line 64 – Col. 26, line 6).

Re. Claim 11, Clark discloses an integrated system wherein the authentication system provides access to all applications using a single logon process (Col. 25, line 64 – Col. 26, line 24).

3.   Claim 12 is rejected under 35 U.S.C. 103(a) as being disclosed by Clark in view of Wolfberg and Earle.

Re. Claim 12, Clark discloses a workstation for use in providing financial assistance to investors conducting investor mediated transactions over an online transaction system, the workstation comprising:

- a central processing unit (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15);
- a video display screen (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15);
- an application interface operable on the workstation for accessing at least one finance-related software application (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and
- an investor monitoring system for monitoring investor mediated transactions conducted by the investor on the online transaction system, wherein the workstation is connected to at least one host server over a communication system which enables communication between the workstation and at least one host server, wherein the investor monitoring system monitors at least one investor account for at least one investor account mediated transaction and communicates to the financial advisor a communication regarding the at least one investor-mediated transactions on a real-time basis upon the at least one investor mediated transaction, the financial advisor therewith able to proactively intercede in the investor mediated transaction (Col. 5, line 63 – Col. 6, line 16; Col. 10, l. 49; Col. 11, ll.16-23; Col. 13, lines 63-64).

Clark does not explicitly disclose a financial advisor receiving a communication regarding an investor mediated transaction and the financial advisor proactively interceding in the investor mediated transaction. However, Wolfberg discloses providing timely proactive transaction advice to the client (Col. 24, ll. 43-52). Also, Clark do not

explicitly disclose enabling a financial advisor user therewith to provide timely proactive transaction advice to the client user. However, Earle discloses the enabling of a user therewith to provide timely proactive transaction advice to the client user (Col. 7, II. 48-59; Col. 9, II. 54-57). It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Wolfberg and Earle for the purpose of a financial advisory system and workstation that supports the focusing of individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, protects them from mistakes and, perhaps most importantly, provides an opportunity for their financial decisions to meet their investment goals for the future. The motivation for the practitioner at the time of Applicant's invention to invent such a system would have been motivated by the desire to provide a vehicle by which financial transactions can be made in a timely, reliable and synchronous basis (Earle, Col. 4, II. 11-14).

4.   **Claim 2**   *is*   **rejected** under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Maggioncalda, Wolfberg and Earle as applied to claim 1 above, and further in view of Petruzzi (US Patent 5,806,049) and Fox (US Patent 5,132,899).
Re. Claim 2, Clark discloses an integrated system as recited by claim 1, wherein the plurality of finance-related software applications further comprise at least one finance related software application selected from the group consisting of (Col. 3, lines 17-23):

- a real-time market data application (Col. 10, line 49; Col. 11, line 18);
- a client information application (Clark, Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15);
- an office productivity application (Fig. 15).

However, Clark does not explicitly disclose:

- a financial planning application;
- a calculator application;
- an investment products application;
- an opportunities application opportunities application; and

- an investment research application.

Maggioncalda discloses:

- a financial planning application (Col. 2, line 33 – Col. 3, line 63; Col. 5, lines 32-33);

- a calculator application (Col. 1, lines 31-48; Col. 8, lines 24);

- an investment products application (abstract; Col. 2, lines 12-30, 54-65).

Also, Petruzzi discloses an opportunities application (Title); and

Fox discloses an investment research application (Fox Col. 5, lines 45-53; many available, among best known available on line is Value Line).

It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda, Petruzzi and Fox for the purpose of a financial advisory system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, and, perhaps most importantly, illustrates the chance that their financial decisions combined with the recommended financial products will meet their needs in the future (Maggioncalda, Col. 1, ll. 54-55).

5.   Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Wolfberg and Earle as applied to claim 12 above, and further in view of Maggioncalda, Petruzzi and Fox.

Re. Claim 13, Clark discloses a workstation as recited by claim 12, wherein the financial-related software application comprises at least one finance-related software application selected from the group consisting of (Col. 3, lines 17-23):

- a real-time market data application (Col. 10, line 49; Col. 11, line 18);

- a client information application (Clark, Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and

- an office productivity application (Fig. 15).

However, Clark does not explicitly disclose

- a financial planning application;

- a calculator application;

- an investment products application;

- an opportunities application; and

- an investment research application.

Maggioncalda discloses a workstation as recited by claim 12, wherein the finance-related software applications are selected from the group comprising:

- a financial planning application (Col. 2, line 33 – Col.3, line 63, Col. 5, lines 32-33);

- a calculator application (Col. 1, lines 31-48; Col. 8, line 24); and

- an investment products application (Abstract; Col. 2, lines 12-30, 54-65).

Petruzzi discloses an opportunities application (Title); and

Fox discloses an investment research application (Col. 5, lines 45-53).

It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda for the purpose of a financial advisory system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, and, perhaps most importantly, illustrates the chance that their financial decisions combined with the recommended financial products will meet their needs in the future (Maggioncalda, Col. 1, ll. 54-55).

6.   **Claim 14 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Clark, in view of Earle.

Re. Claim 14, Clark discloses an authentication system for creating an application interface of a financial assistance system, the authentication system comprising:

- means for allowing access to a plurality of finance-related software applications permitted by a user entitlement level, the plurality of finance-related software applications comprising, a real-time market data application and a financial planning application (Abstract – ll. 12-14; Col. 2, lines 48-50; Col. 5, line 63 – Col. 6, line 16; Col. 6, lines 36-47);

- means for providing user preferences that allow user to customize the application interface (Col. 2, II. 36-58; Col. 3, II. 17-34);

- a system for controlling the access to applications and the user preferences (Col. 25, line 64 – Col. 26, line 24); and

- a real time investor monitoring system for monitoring investor mediated transactions conducted by an investor on an online transaction system and communicating a communication regarding at least one investor-mediated transaction on a real-time basis upon detecting the at least one investor mediated transaction (Real time - Col. 10, line 49; Col. 11, II. 16-23).

Clark does not explicitly disclose an investor's communication to a financial advisor. However, Earle discloses an investor's communication to a financial advisor (Col. 7, II. 48-59; Col. 9, II. 54-57). It would have been obvious to an ordinary practitioner at the time of Applicant's invention to have modified the disclosure of Clark with that of Earle for the purpose of an authenticated financial assistance system which has the capability to have investors communicate with financial advisors for the purpose of providing a vehicle by which financial transactions can be made in a timely, reliable and synchronous basis (Earle, Col. 4, II. 11-14).

7.   **Claims 15 and 16 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Maggioncalda.

Re. Claim 15, Clark discloses a system for providing financial information to end users in a workstation and a host computer comprising:

- an application interface having:
  - o means for selectively running finance-related software applications simultaneously (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and
  - o means for controlling the display of the finance-related software applications, the plurality of finance-related software applications comprising a real-time market data application (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and

an authentication system having:

- o means for determining a set of finance-related software applications that a user is entitled to selectively run and display (Fig. 15; Abstract; Col. 2, lines 48-50; Col. 5, line 63 – Col. 6, line 16; Col. 6, lines 36-47); and

- o means for setting user preferences that allow a user to customize the application interface for the user based on a stored user preference profile (Col. 2, ll. 36-58; Col. 3, ll. 7-34; Col. 25, line 64 – Col. 26, line 24).

Clark do not explicitly disclose the providing of all inclusive financial advice, such as financial planning advice. However, Maggioncalda et al. do disclose the providing of a financial planning application (Col. 2, line 33 – Col. 3, line 63; Col. 5, lines 32-33). It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda for the purpose of a financial advisory system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, and, perhaps most importantly, illustrates the chance that their financial decisions combined with the recommended financial products will meet their needs in the future.

Re. Claim 16, Clark discloses a system as recited by claim 15, further comprising means for executing a controller that maps server names; retrieves entitlement levels; retrieves entitlement data; retrieves user preference profile; creates a local user directory; activates application interface with retrieved entitlement data and user preferences; and launches application interface (Col. 25, line 64 – Col. 26, line 24).

Response to Arguments

8.   Applicant's arguments filed January 28, 2004 with respect to claims 1, 2-11, 14 and 15 have been considered but are moot in view of the new ground(s) of rejection.

A.   Applicant is advised to refer back to the responses to Applicants' arguments which are contained in the last Office Action.

B.   Regarding Applicant's argument that "the automation trend teaches away from the present invention insofar the present invention provides a real-time overseeing function to automated online transaction systems that is costlier due to human

involvement that is contrary to the trend" (Page 7, II. 29-31). Applicant is referred to the examiner's response to this argument in the last Office Action. Applicant is further advised that the automation trend does not teach away from the present invention because service level is a function of investment scale. Automation is being applied to all levels of investment management regardless of scale. However, hands on investment advisors have minimums between $ 5000,000 and $ 1 million of managed capital in recent years because that level of investment management makes it affordable to provide service.

Automation is merely bringing the minimums down to reach smaller investment portfolios, thus increasing the size of the market. One major investment management firm has established an automated investment management service for a minimum managed capital of $ 50,000, with a minimal amount of live investment advisor contact. At the same time, the number of investors who have larger amounts of capital to invest has increased dramatically since 1980, as reported by various news publications under the headline that the top 20% of US workers have dramatically increased their income at a far greater rate than the rest of US workers, thus increasing the market of larger managed investment portfolios. For example, the originator of no frills computer automated online brokerage services, Charles Schwab and Company, has steadily increased its offering of investment adviser services during this time frame in this scenario to reap the benefits of managing larger investment pools which offer higher fee income potential.

C. Re. Claim 15, regarding Applicant's argument that "none of the references cited by the examiner disclose or otherwise suggest means for selectively running and displaying the plurality of finance-related software application simultaneously ..... (and) the user to customize the application interface" (page 8, II. 10-14). Applicant is essentially arguing that it is not obvious that one make full use of all the tools made available by computer operating systems, such as MS Windows, and the various other tools made available through the internet, the worldwide web, and the variety of hardware tools, all of which are constantly being made to perform to new performance levels. As referenced in the above rejections, Clark teaches the full use of the tools and

techniques available by operating systems and the internet, such as in Col. 2, ll. 36-58;
Col. 3, ll. 7-34; Col. 25, line 64 – Col. 26, line 24. Clark also teaches the use of finance
related software applications. The simultaneous running is taught generally by the
teaching to use all available operating system techniques. Further, Maggioncalda
teaches the full use of additional financial systems, such as a financial planning
application, Col. 2, line 33 – Col. 3, line 63; Col. 5, lines 32-33.

Conclusion

9.   Applicant's amendments necessitated the new ground(s) of rejection presented
in this Office action.

Any inquiry concerning this communication or earlier communications from the
Examiner should be directed to Siegfried Chencinski whose telephone number is
(571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to
6pm.
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's
supervisor, Hyung S. Sough, can be reached on (571) 272-6799.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should
you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231
or faxed to:

(703)872-9306   [Official communications; including After Final communications
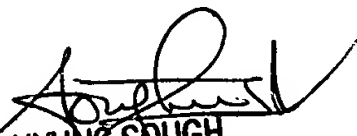   labeled "Box AF"]

(571) 273-6792   [Informal/Draft communications, labeled "PROPOSED" or

"DRAFT"]

Hand delivered responses should be brought to the address found on the above

USPTO web site in Alexandria, VA.

SEC

April 18, 2005

HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600